

REMARKS RESPONSIVE TO THE OFFICE ACTION

Claims 1-13 are pending, and Claims 1-13 have been rejected. Reconsideration and allowance are respectfully requested in light of the below presented argument specifically disclosing the distinctions between the references cited and the present invention, and provisions of law cited relevant to the propriety of the rejections made.

CLAIM REJECTIONS – 35 USC § 103(a)

RE: CLAIM 1

Claims 1-13 rejected under 103(a) as being unpatentable over Kam et al. US 2001/0042037 A1 (Kam), and further in view of Guheen et al. US 6,615,166 B1 (Guheen).

APPLICANT'S RESPONSE RE: CLAIM 1

Applicant again appreciates Examiner's careful attention to the examination of this Application. Applicant provides the following response and respectfully traverses Examiner's rejection.

The cited references do not teach, or suggest, the essential elements of the claimed invention.

Applicant respectfully asserts that a cursory and straightforward examination of Kam, made without overly broad interpretations, and without improper assumptions, inferences, or conclusory assessments, reveals that *the reference Kam fails to disclose or suggest, anywhere within its several pages, the core elements of the present invention.* Specifically, nowhere within the hundreds of pages of Kam and Guheen is there any disclosure or suggestion whatsoever of using values representing performances of products (which could include mutual funds) to derive an independent value, and then to use that value to select and display an animated contest file. They simply do not perform these steps at any time. Furthermore, the cited art provides no suggestion or motivation to perform the claimed steps, alone, combined, or properly combined with any other art cited at any time during the prosecution of this Application. On this basis alone, the present invention is both novel and non-obvious and is entitled to allowance.

The cited reference teaches away from the present invention, and provides no motivation to arrive at the limitations of the claimed invention.

From Claim 1¹:

...solving for a contest value between the first product value and the second product value;

selecting an animated contest file by relationship to the contest value...

Examiner states that he believes²:

"II. Operation of actual portfolios by members, including new ones created by the identified Best Investors for themselves..."

is conceptually similar to:

"solving for a contest value between the first product value and the second product value."

Applicant respectfully asserts this is incorrect. There is simply no conceptual similarity whatsoever. Properly understood and evaluated, the example relied on by the Examiner demonstrates that Kam teaches away from this step of the present invention by teaching selection of individual investment options with the best scores. This teaches an end to the process and moots entirely consideration of any further comparison, alternative comparison, or contest value derivation.

"Would have been able to produce" is not the standard of obviousness

Examiner correctly acknowledges that:

"Kam does not explicitly specify displaying the animated contest, but at paragraph 0123 teaches notification can be text or icon messages."

Examiner then asserts:

¹ U.S. Patent Application No. 10/758,660, Claim 1.

² Office Action dated July 15, 2006; U.S. Patent Application No. 10/758,660.

"However, the second reference Guheen at col. 32, lines 41-49 teaches Java, which developers can create robust User Interface (UI) components. Custom "widgets" (e.g., real-time stock tickers, animated icons, etc.) can be created, and client-side performance is improved. ... Therefore the deficiency of the first reference may be vanishing by incorporating the second reference of graphical user interfaces using Java."

Examiner summarily concludes:

"Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute applicant's described structure, by incorporating Guheen's graphical tools (i.e., software) into Kam's invention, ..."

Applicant respectfully asserts that this basis for rejection is both incorrect and improper. The rejection is based on a sequence of overly broad interpretations and summary conclusions made to create an alleged nexus of allegedly *"conceptually similar"* elements from wholly unrelated references. As even these summary conclusions fail to teach or suggest the basics of the claimed invention, the rejection relies critically on the Examiner's personal opinion that the mere suggestion of the benefits of Java, found in an unrelated reference, somehow renders the critical steps of the present invention obvious. It most certainly does not. Neither does a text or icon message constitute "an animated contest." The Courts have determined that section 103 requires more than a "would have been able to produce" test. "The statute requires much more, i.e. that it would have been *obvious* to produce the claimed invention at the time it was made without the benefit of hindsight."³ Again, the references do not disclose or suggest the essential elements of the claimed invention.

A clear and particular showing of actual evidence of teaching or motivation to combine is required – broad conclusory statements are insufficient.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.⁴ The Examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching

³ *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986).

⁴ *In Re Anita Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, (abrogated on other grounds) (Fed. Cir. 1999) citing *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2D (BNA) 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding").

[leading to the combination]”.⁵ Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.⁶ The showing must be clear and particular. “*Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."*”⁷ No such evidence exists in the present references. The only evidence in the present matter is *contrary* to any suggestion or motivation for combination.

The Guheen reference discloses a system for prioritizing components of an existing computer network. It is wholly unrelated to the field of art of comparing products and services, to which the present invention is directed. As a result, Applicant respectfully asserts that Examiner has combined Guheen and Kam without evidence of the propriety for doing so, in a hindsight analysis of the numerous features of Applicant's present invention, supported only by broad conclusory statements.

The claimed invention is fully supported by the specification.

As requested by the Examiner, Applicant directs the Examiner's attention to the support in the specification for the limitations referenced in the above response. The following tables and paragraphs, among several others, provide detailed support for claimed contest value and claimed selection of animated graphic files.

TABLE 1 of the specification demonstrates an association of contest values with corresponding graphic files. TABLE 3 discloses an array relationship between product test results, calculated contest values, and indication of the best performing product. TABLE 5 discloses an array relationship between calculated contest values and combat sequences, whereas the length of the battle depicts the closeness of the battle. Paragraphs [0034] – [0040] further detail the product value, contest value and animated file relationships, as does the balance of the specification.

Applicant is respectful of Examiner and Examiner's hard work in this case, but these references are irrelevant to the present invention, and this is clearly demonstrated by the

⁵ *Id.*, citing *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992).

⁶ *Id.*, citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. (BNA) 543, 547 (Fed. Cir. 1985).

⁷ *Id.*, citing *C.R. Bard*, 157 F.3d at 1352, 48 U.S.P.Q.2D (BNA) at 1232.

absence of any teaching, suggestion or motivation to arrive at the essential limitations of the claimed invention.

APPLICANT'S RESPONSE RE: CLAIMS 2-9

Since Claims 2 through 9 depend from Claim 1, and Claim 1 is allowable, Applicant asserts that they are allowable as depending from an allowable claim.

RE: CLAIMS 10-13

The rejection of claim 1 is applicable to the rejection of claims 10-13.

APPLICANT'S RESPONSE RE: CLAIMS 10-13

Applicant's response to the rejection of Claim 1 is applicable in response to the rejection of Claims 10-13, and is fully incorporated here for that purpose. On the basis of that response, Applicant respectfully traverses Examiner's rejections.

REMARKS RESPONSIVE TO THE INTERVIEW SUMMARY

RE: INTERVIEW SUMMARY

An interview was conducted August 23, 2006. Examiner prepared an Interview Summary, which included the following text:

Continuation Sheet (PTOL-413)

Application No. 10/758,660

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Examiner explained to Mr. Fischer reasons for having three non-final rejections especially the non-final rejection dated 7/19/06. After Examiner carefully studied the claim invention and searched the prior arts, found two prior arts, which are conceptually similar to claim invention from viewpoint of a person skilled in the art. Examiner demonstrated a simple example, e.g., a recycle bin in Microsoft windows a simulated garbage can used for deleting files and folders that can be considered as two stages, one when it is empty and the second stage considers as when is contained some documents. The first stage as graphical object represents the performance, and the same thing applies to the second stage. It is obviously the relationship between the two stages can be displayed graphically on a screen i.e. the animated contest. Examiner's suggestion: Mr. Fischer may be amended the claim language of "...Product's performance" to more detailed terminology toward the claimed invention. Also needs to explain more about the term "the animated contest", because the animated contest may easily apply to recycle bin i.e. animated from one stage to another stage. Does the animated contest include different interval of time?

In response to Examiner's recycle bin example, Applicant incorporates his response above to the cited prior art. In further response, Applicant respectfully asserts that Examiner's example is irrelevant to the present invention for at least the following reasons:

1. The example fails to disclose or suggest any determination of a first product value representing a first product's performance.
2. The example fails to disclose or suggest any determination of a second product value representing a second product's performance.
3. The example fails to disclose or suggest any resolution of a contest value between the first product value and the second product value.
4. The example fails to disclose or suggest any step of selecting an animated contest file by relationship to the contest value.
5. The example fails to disclose or suggest any display of an animated contest.

Displaying a recycle bin has never before been associated with determination of a product value of any kind. Applicant respectfully asserts that Examiner's attempt to create a relatable example that doesn't presently exist is, by definition, an improper hindsight analysis. The example should be dismissed as improper on this basis alone. Still further, Examiner's example is, like the other prior art cited, mute with regards to the core elements of the present invention, namely determination of product values, resolution of a contest value, and selecting an animated contest file by relationship to the contest value. Each of the missing elements is present in Claim 1 of Applicant's invention. As discussed herein above, the specification of Applicant's application fully supports and defines the claimed elements, and additional detail within the claims is not required.

With regards to Examiner's suggestion of what could have been done as to an animated display, Applicant objects to this argument and again asserts that "would have been able to produce" is not the standard of obviousness.

Applicant respectfully finds Examiner's example to be misplaced, as there is no realistic similarity, nor obviousness, between the present invention as claimed and Examiner's cited example. On the basis of this response, Applicant respectfully traverses Examiner's assertion of obviousness to the created example.

In addition to Examiner's summary, it is noted that during the Interview, Applicant respectfully declined Examiner's suggestion that Applicant further narrow the claims on the basis that they "seemed too broad" to the Examiner. Applicant replied, and again replies, that neither Examiner in this case has identified any proper basis for amending or narrowing the claims in any of the several prior art items cited, nor does such basis exist in Examiner's interview example. Professional patent practice mandates that Applicant respectfully decline Examiner's invitation to amend the claims absent such basis.

CONCLUSION

Applicant appreciates Examiner's thorough review of the prior art, and Examiner's remarks related thereto, and Examiner's courtesy during the interview. The Application has been carefully reconsidered in view of this most recent Office Action of July 19, 2005, and on the basis of Examiner's comments during the interview. On the basis of the above responses, Applicant respectfully submits that the only stated grounds for rejection of Applicant's claims have been addressed and traversed. Applicant respectfully asserts that the above response again places this Application in condition for allowance. Consideration of this Application for immediate allowance is requested.

Applicant does not believe that any fees are due; however, in the event that any fees are due, the Commissioner is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper to Deposit Account 50-2180 of Storm LLP.

Should the Examiner require any further clarification to place this Application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

Date: 9/8/06


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